

REMARKS

Replacement drawings sheets are included herewith, as requested by the Examiner.

By this amendment, the limitations of claim 2 have been moved into claim 1, and claim 2 has been cancelled. New claims 6-13 have been added, wherein claim 6 includes the limitations of claim 3 in independent form, and claim 9 includes the limitations of claim 4 in independent form.

Claim 2 was rejected under 35 U.S.C. §103(a) over Steffee ('388), in view of Hunt ('768). The Examiner argues that it would have been obvious "to construct the system of Steffee with the screw of Hunt in order to lock the screw in position as preventing that it is removed." Applicant respectfully disagrees.

In rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to combine the cited references to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggests the proposed combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior-art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In this case, Steffee discusses a fastener beginning at column 3, line 37 to column 4, line 4, and nowhere does Steffee teach or suggest the need or even the desirability of tangs or barbs to assist with fixation. Likewise, Hunt is entirely silent with respect to orthopaedics. Indeed, Hunt represents non-analogous art.

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

In this case, Steffee is concerned with maintaining vertebrae in a desired spatial relationship, whereas Hunt is concerned that vessels containing articles of merchandise are fraudulently opened during transportation, and that other times, their contents pilfered (column 1, lines 19-23). Thus, the reference is not in Applicant's field of endeavor and is not reasonably pertinent to the particular problem with which the inventor was concerned, namely, in combination, an orthopaedic fixation system.

Claim 6 includes the limitation of a bone anchor having a proximal end which is substantially at the surface of a bone once in position. Although the Examiner rejected this claim under 35 U.S.C. §102(b) over Steffee, no reason was given and, in fact, the bone anchor of Steffee extends way beyond a bone surface, thereby precluding anticipation. The same holds true of claim 9. Although this was rejected under 35 U.S.C. §102(b) over Steffee, Steffee neither teaches nor suggests "an elbow," such that anticipation is not established.

Based upon the foregoing remarks, Applicant believes all pending claims continue to be condition for allowance. Any questions regarding this response may be directed to the undersigned attorney by telephone, facsimile or electronic mail.

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Respectfully submitted,
By: _____

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